



UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,011	06/15/2000	Tooru Kamibayashi	04329.2320	9094

22852 7590 07/27/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
----------	--------------

2135

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/594,011

Applicant(s)

KAMIBAYASHI ET AL.

Examiner

Tom Gyorfi

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 8-10, 13, 15, 16, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8-10, 13, 15, 16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-3, 6, 8-10, 13, 15, 16, 18, and 19 remain for examination. The correspondence filed 5/9/05 amended claims 1-3, 6, 8-10, 13, 15, 16, 18 and 19; and cancelled claims 7, 14, 17, and 20.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/9/05 has been entered.

Response to Arguments

3. Applicant's arguments, see the Request for Continued Examination filed 5/9/05, with respect to the rejection(s) of claim(s) 1-3, 6, 8-10, 13, 15, 16, 18 and 19 under Traw have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Traw, Harari, Watanabe, and Yasu.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 6, 8-10, 13, 15, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Traw (U.S. Patent 5,949,877), Harari et al. (U.S. Patent 5,602,987), Watanabe (U.S. Patent 5,450,366), and Yasu et al. (U.S. Patent 5,912,849).

Referring to Claims 1, 2 and 9:

Traw discloses a storage medium comprising:

a specified storage area on which revocation information is registered, the revocation information being used to determine whether or not use of the storage medium by an electronic device is to be revoked (col 6, lines 45-55). Further, Traw also discloses a controller which determines whether or not use of the storage medium by an electronic device which attempts to access to the storage medium is to be revoked (col 3, lines 40-45), based on the revocation information registered on the specified storage area and information sent from the electronic device (col 3, lines 30-45; col 6, lines 45-60), wherein the controller sends a key needed for a content exchange to the electronic device when the controller does not determine that use of the storage medium by the electronic device is to be revoked (col 8, lines 30-55), and wherein a content which is

Art Unit: 2135

encrypted using the key is written on a predetermined storage area of the storage medium by the electronic device (col 8, lines 40-55).

Traw does not explicitly disclose wherein the storage medium is a memory card, nor that the disclosed controller is embedded within the memory card; however, it should be noted that the list of permissible media includes magnetic disk drives [i.e. floppy disks and hard drives], but is open-ended (col. 12, lines 15-20). Harari discloses a memory card storage medium (col. 2, lines 54-59) comprising a controller embedded in the memory card (col. 5, lines 5-20 and Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a memory card similar to that disclosed by Harari as the media to be protected by the invention disclosed by Traw. One would be motivated to do so because the invention disclosed by Harari constitutes an improvement over magnetic disk drives (Harari, col. 1, lines 17-23 and 45-50).

Neither Traw nor Harari disclose a storage portion including a secret area which is capable of being accessed by a specific secret procedure. However, Watanabe discloses a memory card comprising a secret area which is capable of being accessed by a specific secret procedure (col. 6, line 58 – col. 7, line 5). It would have been obvious to partition the storage area in the memory card used in the combination of Traw and Harari. The motivation for doing so would be to make it possible to safely contain copyrighted material without permitting infringement (col. 2, lines 50-55).

Traw, Harari, and Watanabe are silent regarding the public area of the memory card including both a rewritable public area and a read-only public area. However,

Art Unit: 2135

Yasu discloses a memory card including both a rewritable public area and a read-only public area (col. 2, lines 20-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to partition the publically accessible memory of the memory card in the previously disclosed combination into rewritable and read-only portions. The motivation for doing so would be to be able to use the same type of physical memory circuitry that can be substituted with both conventional RAM and ROM devices (col. 2, lines 55-60).

Referring to Claim 8:

Traw disclose a contents protection method comprising the steps of:
providing a specified storage area on storage medium and registering revocation information on the specified storage area, the revocation information being used to determine whether or not use of the storage medium by an electronic device is to be revoked (col 6, lines 45-55);

determining [by a controller on a memory card] whether or not use of the storage medium by an electronic device which attempts to access to the storage medium is to be revoked (col 3, lines 40-45), based on the revocation information registered on the specified storage area and information sent from the electronic device (col 3, lines 30-45; col 6, lines 45-60); sending a key needed for a content exchange to the electronic device when it is not determined that use of the storage medium by the electronic device is to be revoked (col 8, lines 30-55); and

writing a content which is encrypted using the key on a predetermined storage area of the storage medium by the electronic device (col 8, lines 20-50).

Traw does not explicitly disclose wherein the storage medium is a memory card, nor that the disclosed controller is embedded within the memory card; however, it should be noted that the list of permissible media includes magnetic disk drives [i.e. floppy disks and hard drives], but is open-ended (col. 12, lines 15-20). Harari discloses a memory card storage medium (col. 2, lines 54-59) comprising a controller embedded in the memory card (col. 5, lines 5-20 and Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a memory card similar to that disclosed by Harari as the media to be protected by the invention disclosed by Traw. One would be motivated to do so because the invention disclosed by Harari constitutes an improvement over magnetic disk drives (Harari, col. 1, lines 17-23 and 45-50).

Neither Traw nor Harari disclose a storage portion including a secret area which is capable of being accessed by a specific secret procedure. However, Watanabe discloses a memory card comprising a secret area which is capable of being accessed by a specific secret procedure (col. 6, line 58 – col. 7, line 5). It would have been obvious to partition the storage area in the memory card used in the combination of Traw and Harari. The motivation for doing so would be to make it possible to safely contain copyrighted material without permitting infringement (col. 2, lines 50-55).

Traw, Harari, and Watanabe are silent regarding the public area of the memory card including both a rewritable public area and a read-only public area. However,

Art Unit: 2135

Yasu discloses a memory card including both a rewritable public area and a read-only public area (col. 2, lines 20-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to partition the publically accessible memory of the memory card in the previously disclosed combination into rewritable and read-only portions. The motivation for doing so would be to be able to use the same type of physical memory circuitry that can be substituted with both conventional RAM and ROM devices (col. 2, lines 55-60).

Referring to Claims 3, 10, 15 and 18:

The above combination disclose the limitation of Claims 1, 2, 8 and 9 above. Traw further discloses the controller determines that use of the memory card by the electronic device should be revoked, a subsequent process is halted (col. 8, lines 10-15).

Referring to Claims 6, 13, 16 and 19:

The above combination discloses the limitation of Claims 1, 2, 8 and 9 above. Traw further discloses the read-only public area is a storage area provided on a read-only non-volatile memory (col 12, lines 15-25).

Art Unit: 2135

Conclusion


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: the web page "SanDisk and Lexar Settle Patent Disputes" © 2000 Lexar Media Inc. http://www.lexar.com/newsroom/press/press_11_14_00.html

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAG
7/21/05


KIM VU
SUPERVISORY PATENT EXAMINER
ELECTRONIC BUSINESS CENTER 2100